

REMARKS:

Claims 1-43 are currently pending in the application. Claims 11-26, 37-40 and 42 are withdrawn from consideration. Claims 1 and 27 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,366,910 to Rajaraman et al. ("Rajaraman"). Claims 1-10, 27-36, 41 and 43 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,366,910 to Rajaraman et al. ("Rajaraman") in view of U.S. Patent No. 6,078,891 to Riordan et al. ("Riordan") and in further view of U.S. Patent No. 6,578,014 to Murcko Jr. ("Murcko").

REJECTION UNDER 35 U.S.C. § 102(e):

Claims 1 and 27 stand rejected under 35 U.S.C. § 102(e) over Rajaraman.

The Office Action alleges that Rajaraman discloses product classes, and attributes of the product class, pointers for each product class, each pointer identifying a seller database associated with each seller attributes, and a search interface and a search query for product data. The Office Action also alleges that Rajaraman "already teach[es] an e-commerce concept that includ[es] structures as claimed." The Applicant has reviewed Rajaraman in detail, particularly looking for product classes including defining one or more attributes of the product class, pointers for each product class and a search interface and a search query for product data, relied upon by the Examiner. However, Rajaraman fails to disclose each and every limitation recited by independent claims 1 and 27. Thus, the Applicant respectfully submits that independent claims 1 and 27 patentably distinguish over Rajaraman.

For example, with respect to independent claim 1, this claim recites:

A system providing seller pre-qualification during the matching phase of an electronic commerce transaction, comprising:

a directory structure comprising a plurality of hierarchically organized product classes, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class;

one or more pointers for each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class, each seller database associated with a seller having values for one or more seller attributes; and

a search interface operable to communicate, in response to selection of a product class and specification of one or more seller attribute criteria, a search query for product data only to one or more seller databases associated with sellers having seller attribute values matching the specified seller attribute criteria, these seller databases being identified by the one or more pointers associated with the selected product class. (Emphasis Added).

Independent claim 27 recites similar limitations. Rajaraman fails to disclose each and every limitation of independent claims 1 and 27.

For example, Rajaraman fails to disclose a directory structure comprising a plurality of hierarchically organized product classes, and defining one or more attributes of the products categorized in the product class. Although Rajaraman discloses a system for querying hierarchically classified data, (Abstract), Rajaraman does not disclose defining one or more attributes of products categorized in the plurality of hierarchically organized product classes. In fact, Rajaraman teaches away from the claimed invention since the first query request received by Rajaraman is inefficient because of the larger amount of searching involved in finding a product classification. Furthermore, once Rajaraman displays the various offerings of that product classification there are various sub-classifications based on the hierarchy of classifications that cannot be easily resolved or adjusted.

The Applicant further submits that Rajaraman does not disclose a pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class. Although Rajaraman discloses a pointer to the entries of a term table that contain that term; the pointer is only contemplated for use provided a term exists in the term table, (Column 7, Lines 43-61), Rajaraman does not point to a seller database, where product data is stored for products characterized in the plurality of hierarchically organized product classes.

The Applicant further submits that Rajaraman does not disclose a search interface and a search query for product data. As mentioned above, Rajaraman does not disclose a pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class. Thus, Rajaraman cannot provide a search interface operable to communicate, in response to selection of a product class since Rajaraman does not even provide a pointer associated with the selected product class.

Thus, the allegation in the present Office Action that Rajaraman discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Rajaraman is considered to anticipate all of the limitations in independent claim 1. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. Applicant respectfully points out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submits that the Office Action has failed to establish a prima facie case of anticipation in independent claim 1 under 35 U.S.C. § 102 with respect to Rajaraman because Rajaraman fails to identically disclose every element of the Applicant's claimed invention, arranged as they are in Applicant's claim.

With respect to independent claim 27, this claim includes limitations similar to those discussed above in connection with independent claim 1. Thus, independent claim 27 is considered patentably distinguishable over Rajaraman for at least the reasons discussed above in connection with amended independent claim 1.

Thus, for the reasons set forth herein, the Applicant submits that claims 1 and 27 are not anticipated by Rajaraman. The Applicant further submits that claims 1 and 27 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1 and 27 under 35 U.S.C. § 102(e) be reconsidered and that claims 1 and 27 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-10, 27-36, 41, and 43 stand rejected under 35 U.S.C. § 103(a) over Rajaraman in view of Riordan and in further view of Murcko.

Claims 1-10, 27-36, 41, and 43 stand rejected under 35 U.S.C. § 103(a) over Rajaraman in view of Riordan and in further view of Murcko. The Applicant respectfully submits that Rajaraman, Riordan, or Murcko either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1-10, 27-36, 41, and 43. Thus, the Applicant respectfully traverses the Examiners obvious rejection of claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 103(a) over the proposed combination of Rajaraman, Riordan, and Murcko either individually or in combination.

For example, with respect to independent claim 1, this claim recites:

A system providing seller pre-qualification during the matching phase of an electronic commerce transaction, comprising:

a directory structure comprising a plurality of hierarchically organized product classes, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class;

one or more pointers for each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class, each seller database associated with a seller having values for one or more seller attributes; and

a search interface operable to communicate, in response to selection of a product class and specification of one or more seller attribute criteria, a search query for product data only to one or more seller databases associated with sellers having seller attribute values matching the specified seller attribute criteria, these seller databases being identified by the one or more pointers associated with the selected product class. (Emphasis Added).

Independent claims 27, 41, and 43 recite similar limitations. Rajaraman, Riordan, and Murcko either individually or in combination, fail to disclose each and every limitation of independent claims 1, 27, 41, and 43.

For example, Rajaraman fails to disclose a directory structure comprising a plurality of hierarchically organized product classes, and defining one or more attributes of the products categorized in the product class. Although Rajaraman discloses a system for querying hierarchically classified data, (Abstract), Rajaraman does not disclose defining one or more attributes of products categorized in the plurality of hierarchically organized product classes. In fact, Rajaraman teaches away from the claimed invention since the first query request received by Rajaraman is inefficient because of the larger amount of searching involved in finding a product classification. Furthermore, once Rajaraman displays the various offerings of that product classification there are various sub-classifications based on the hierarchy of classifications that cannot be easily resolved or adjusted.

The Applicant further submits that Rajaraman does not disclose a pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class. Although Rajaraman discloses a pointer to the entries of a term table that contain that term; the pointer is only contemplated for use provided a term exists in the term table, (Column 7, Lines 43-61), Rajaraman does not point to a seller database, where product data is stored for products characterized in the plurality of hierarchically organized product classes.

The Applicant further submits that Rajaraman does not disclose a search interface and a search query for product data. As mentioned above, Rajaraman does not disclose a pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class. Thus, Rajaraman cannot provide a search interface operable to communicate, in response to selection of a product class since Rajaraman does not even provide a pointer associated with the selected product class.

The Applicant still further submits that the Office Action acknowledges that Rajaraman fails to disclose the emphasized limitations noted above in claim 1. Specifically the Examiner acknowledges that Rajaraman fails to disclose that a seller attribute matches a buyer profile, a search query for product data only to seller databases associated with

sellers identified in the buyer profile. However, the Examiner asserts that the cited portions of Riordan disclose the acknowledged shortcomings in Rajaraman. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in Riordan.

The Applicant respectfully submits that Riordan has nothing to do with the claim 1 limitations regarding matching a seller attribute to a buyer profile. Rather, Riordan describes an approach a merchant uses at a point of sale register to identify a preferred customer via a customer identification number. (Column 1, Lines 36-49). This approach merely allows a merchant to view data for a particular preferred customer using the customer's identification number. Riordan fails to disclose a search query for product data to one or more seller databases associated with sellers identified in a buyer profile.

The Applicant further submits that the Office Action acknowledges that both Rajaraman and Riordan, either individually or in combination, further fail to disclose the limitations of claim 1. Specifically the Examiner acknowledges that both Rajaraman and Riordan fail to disclose a pointer. However, the Examiner asserts that Murcko discloses the acknowledged shortcomings in Rajaraman and Riordan. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Murcko.

The Applicant respectfully submits that Murcko fails to disclose the limitations recited in claim 1 regarding a pointer. Rather, Murcko describes information as an item that sometimes may be a pointer to the actual information, rather than the actual information itself. (Column 11, Lines 18-27). Murko does not point to a seller database, where product data is stored for products characterized in the plurality of hierarchically organized product classes. Murko fails to disclose a pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness. The Office Action merely states that it would have been obvious for one of ordinary skill in the art at the time of invention to combine Rajaraman, Riordan, and Murcko. A recent Federal Circuit case makes it crystal clear

that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Rajaraman, Riordan, or Murcko, either individually or in combination.

Claim 1 is considered patentably distinguishable over the proposed combination of Rajaraman, Riordan, and Murcko for at least the reasons discussed above in connection with independent claim 1. With respect to independent claims 27, 41, and 43 each of these claims includes limitations similar to those discussed above in connection with independent claim 1. Thus, independent claims 27, 41, and 43 are considered patentably distinguishable over the proposed combination of Rajaraman, Riordan, and Murcko for at least the reasons discussed above in connection with independent claim 1.

With respect to dependent claims 2-10 and 28-36, claims 2-10 depend from independent claim 1 and claims 28-36 depend from independent claim 27. As mentioned above, each of independent claims 1, 27, 41 and 43 are considered patentably distinguishable over the proposed combination of Rajaraman, Riordan, and Murcko. Thus, dependent claims 2-10 and 28-36 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicant submits that claims 1-10, 27-36, 41, and 43 are not rendered obvious by the proposed combination of Rajaraman, Riordan, and Murcko. The Applicant further submits that claims 1-10, 27-36, 41, and 43 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-10, 27-36, 41, and 43 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

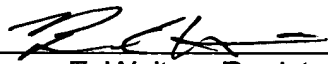
Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

27 MAY 2005

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